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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,226	11/17/2003	Takanori Kamoto	1247-0525P	7013

2292 7590 10/31/2005

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EXAMINER

FAISON, VERONICA F

ART UNIT PAPER NUMBER

1755

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,226

Applicant(s)

KAMOTO ET AL.

Examiner

Veronica F. Faison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21,22,47 and 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21,22,47 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Claims 1-20, 23-46 and 49-52 have been canceled. Hence, claims 21, 22, 47 and 48 are pending in the application.

Double Patenting

Claims 21-22 and 47-48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 54, 57, 60, 63, 70, 75, 85 and 92 of copending Application No. 10/665,088.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both ink composition disclose dynamic surface tension and static surface tension wherein the difference between the two surface tension overlap (i.e in 10/665,088 the difference is represented by $0 \leq [\text{dynamic surface tension (mN/m)}] - [\text{static surface tension (mN/m)}] \leq 7 \text{ (mN/m)}$ and in 10/713,226 the difference is $0 \text{ mN/m} \leq dl \leq 15 \text{ mN/m}$ wherein dl is difference between dynamic surface tension and static surface tension).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21, 22, 47 and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato (US Patent 6,440,203).

Kato teaches an ink composition comprising a first colorant, a second colorant, a penetrating agent, water and a water-soluble organic solvent. The first colorant is a pigment which is dispersible and/or dissolvable in water without any dispersant (abstract and col. 2 lines 32-45). The reference also teaches that any pigment can be used (col. 2 lines 64-65). Pigments such as carbon black, Pigment Yellow 74, 138, 150 and 180, Pigment Red 122 and 202, Pigment Blue 15:3 and 15:4 may be present in the ink composition in the amount of 0.1 to 10 percent by weight (col. 3 lines 31-56). The penetrating agent include glycol ether and/or acetylene glycol surfactants, wherein the glycol ether is present in the amount of 1 to 20 percent by weight and the acetylene glycol surfactant is present in the amount of 0.1 to 10 percent by weight (col. 7 line 51-col. 8 line 44). Applicant discloses on page 12, para 0174, that the critical micelle concentration for the surfactant is about 0.001 to 3 percent by weight. The ink composition has a surface tension of about 25 to 50 mN/m (col. 8 lines 45-47). The aqueous solvent comprises water and a water-soluble organic solvent (col. 8 lines 52-53). The ink may further comprise a wetting agent including ethylene glycol, diethylene glycol, and alkyl ether of polyhydric alcohols present in the amount of 1 to 40 percent by weight (col. 9 lines 4-25). The reference also teaches that an ink set comprising a black, cyan, magenta and yellow inks (col. 10 lines 51+ and claims 16-20). The reference remains silent to the properties set forth in claims 1, 2, 27 and 28, however these properties are inherent

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because the reference uses the same components as claimed by Applicant. The composition as taught by Kato appears to anticipate the claimed invention.

Response to Arguments

Applicant's arguments filed 8-16-05 have been fully considered but they are not persuasive.

Applicant argues that the obviousness-type double patenting rejection is without basis. It is the position of the Examiner that although the currently amended claims are directed to an ink set the claims set forth in 10/665,088 still are obvious over the present claims, although Applicant states that 10/665,088 is directed to a specific ink component. However, the specific ink component is also present in the present application, which gives the ink composition the properties set forth in claim 21, 22, 47 and 48.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica F. Faison whose telephone number is 571-272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VFF
10-19-05

A handwritten signature in black ink, appearing to read "Anthony J. Green". The signature is fluid and cursive, with a large, stylized "A" and "G".

ANTHONY J. GREEN
PRIMARY EXAMINER